

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested. Claims 1-6, 8-29, 31-47 and 49-52 are presently active in this case. Claims 1, 8, 17, 24, 31, 40, 46 and 49 amended, and Claims 7, 30 and 48 canceled by way of the present amendment.

In the outstanding Official Action, the Title of the Invention was objected to as not being descriptive; Claims 1-54 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2002/0178213 to Parry et al.; and Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Parry et al. in view of U.S. Patent No. 5,519,786 to Courtney et al.

Turning now to the merits, Applicants' invention is directed to computer based systems for exchanging documents with an application service provider (ASP). As described in the background section of Applicants' specification, one common use for ASPs is for storing and retrieving documents. However, storage and retrieval ASP services create a problem in that voluminous documents must be transmitted between a user and the ASP via the user's network connection which has a limited data transfer capacity. This leads to the communication line between the user and the ASP being busy during extended transmission period times, especially in the case of users having a low data transfer capacity.¹ Applicants' invention provides a mechanism for allowing the user to store and retrieve documents to the ASP without disabling the communication system of the user at inconvenient times.² In order to expedite issuance of a patent in this case, Applicants have amended independent Claims 1, 24 and 46 to clarify the storage and retrieval feature of the present invention.

Specifically, Claim 1 recites a method for managing application service provider (ASP) documents. The method includes requesting a transfer of an ASP document at an ASP

¹ See Applicants' specification at page 2, paragraph [0005] and page 23, paragraph [0077].

² See Applicants' specification at page 23, paragraph [0077].

user device connected to a remote document manager and a remote ASP via a network, and determining whether the ASP document is a storage document for storing in a remote ASP or a retrieval document for retrieving from the remote ASP. Also recited is establishing a predetermined time for effecting a transfer of the ASP document and transferring the ASP document at a predetermined time via the network. Claims 24 and 46 recite similar features in system and means-plus-function claim format.

The cited reference to Parry discloses a business method for seamlessly integrating an ASP hosted service into a customer document at a user location. As described in the background section of Parry, the disclosed invention is particularly suited for ASPs that provide a web site search feature for a third party customer whose site the user has accessed. That is, the invention of Parry is directed to enabling a user to access a desired web site and then search the web site using a remote ASP search tool without leaving the accessed site. Thus, Parry et al. is not directed to a system for transferring documents between an ASP user and an ASP at all. In particular, Parry et al. does not disclose requesting a transfer of an ASP document at an ASP user device connected to a remote document manager and a remote ASP via a network as recited in Applicant's independent claims.

To the extent that the outstanding Official Action considers a simple web page download from a customer or ASP to satisfy the transfer requirements noted above, Applicants note that the cited reference to Parry et al. also does not disclose determining whether the ASP document is a storage document for storing in the remote ASP or a retrieval document for retrieving from the remote ASP as now recited in independent Claims 1, 24 and 46. The outstanding Official Action apparently points to paragraphs [0036]-[0042] of Parry et al. for satisfying this feature.³ However, this portion of Parry et al. merely describes a user 210 being directed to a remote ASP 230 when requesting a site search on a customer 220.

³ See outstanding Official Action at paragraph 11.

Applicants respectfully submit that this description of a conventional site search feature does not meet the requirement of determining whether an ASP document is a storage document for storing in the remote ASP or a retrieval document for retrieving from the remote ASP.

Still further, Parry et al. does not disclose establishing a predetermined time for effecting a transfer of the ASP document and transferring the ASP document at the predetermined time as also required by Claims 1, 24 and 46. As described in Applicants' specification, it is this feature that enables the transfer of documents between an ASP user and an ASP without disabling the communication system of the user at inconvenient times.⁴ The outstanding Official Action points to the "spider" feature of Figure 8 in Parry as meeting these claim limitations. As discussed in Parry et al., a spider is a web search tool that crawls through the customer's entire web site, downloading and storing information for every web page therein. The spider uses hyperlinks and other HTML cues to help it find all the pages on the site. The spider begins indexing the customer's web site as soon as the customer subscribes to the service. An index of the site is maintained in compressed form in a database on the ASP's internet servers.⁵ Thus, the spider feature of Parry et al. relates to the ASP 230 indexing the customer 220 website so that the user 210 can obtain site search results from the ASP 230. Although Figure 8 shows a window available to the customer 220 for setting the frequency for the spider to revisit the website for an update, this feature does not relate to establishing a predetermined time for transferring a document (which is either a storage document or a retrieval document) between a user and an ASP provider as now recited in the independent claims.

For the reasons discussed above, Applicants' invention as now claimed in Claims 1, 24 and 46 patentably define over the cited reference to Parry et al. The secondary reference to Courtney et al. is cited for its disclosure of optical scanning a paper copy, and does not

⁴ See Applicants' specification at page 23, paragraph [0077].

⁵ Parry et al. at paragraph [0101].

Application No. 09/839,221
Reply to Office Action of September 23, 2004

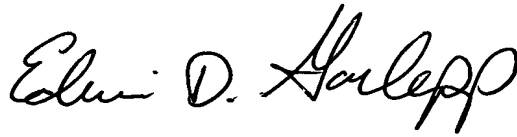
correct the deficiencies of Parry et al. Thus, Applicants' independent Claims 1, 24 and 46 patentably define over the cited references. Moreover, as the remaining pending claims in this case depend from one of these independent claims, the remaining dependent claims also patentably define over the cited references.

Finally, Applicants note that the amendments to Claims 1, 24 and 46 were taken from canceled dependent Claims 7, 30 and 48, respectively. As these dependent claims have already been searched and examined by the Examiner, Applicants respectfully submit that the amendments to Claims 1, 24 and 46 do not raise an issue of new matter that would require further search and/or consideration. Therefore, any forthcoming action on this case that cites new prior art references should not be made final.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599

Edwin D. Garlepp
Registration No. 45,330

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

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